

Serial No. 09/725737

DeMont & Breyer Docket: 500-002US

Express Mail Number: EM 203801068 US

Date of Deposit: May 15, 2009

I hereby certify that this document is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 CFR 1.10 on the date indicated above and is addressed to: Office of the Solicitor, Director of the USPTO, P.O. Box 15667, Arlington, VA 22215

**IN THE UNITED STATES
PATENT AND TRADEMARK OFFICE**

Patent Application

First Inventor: Peter Joseph Giacomini

EM203801068US

Serial No.: 09/725737

Conf. No.: 9624

Filing Date: 11/29/2000

Art Unit: 2616

Examiner: Thong H Vu

Docket No.: 500-002US

Title: Method and Apparatus for Economical Cache Population

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

NOTICE OF APPEAL UNDER 35 U.S.C. §§ 141-142 AND 37 C.F.R. § 1.301

Peter Joseph Giacomini, Walter Michael Pitio, Hector Francisco Rodriguez, and Donald David Shugard hereby appeal to the United States Court of Appeal for the Federal Circuit to review the Decision on Appeal 2009-0139 from Application 09/725,737 of the Board of Patent Appeals and Interferences of the United States Patent and Trademark Office entered on April 15, 2009.

Three copies of this notice of appeal and the decision of the Board of Patent Appeals and Interferences has been transmitted to the United States Court of Appeals for the Federal Circuit.

The decision was received on April 17, 2009.

Serial No. 09/725737

DeMont & Breyer Docket: 500-002US

Respectfully,
Peter Joseph Giacomini et al.

By 

Jason Paul DeMont, Reg. No. 35793
Robert L. Greenberg, Reg. No. 61925
732-578-0103 x211

DeMont & Breyer, L.L.C.
Suite 250
100 Commons Way
Holmdel, NJ 07733
United States of America

CM203801085US

Express Mail Number: EM 203801085 US

Date of Deposit: May 15, 2009

I hereby certify that this document is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 CFR 1.10 on the date indicated above and is addressed to: United States Court of Appeals for the Federal Circuit, Suite 401, 717 Madison Place, N.W., Washington, D.C. 20439

United States Court of Appeals for the Federal Circuit

Ex parte PETER JOSEPH GIACOMINI,
WALTER MICHAEL PITIO, HECTOR
FRANCISCO RODRIGUEZ, and DONALD
DAVID SHUGARD

PETITION FOR REVIEW

Peter Joseph Giacomini, Walter Michael Pitio, Hector Francisco Rodriguez, and Donald David Shugard hereby appeal the court for review of the Decision on Appeal 2009-0139 from Application 09/725,737 of the Board of Patent Appeals and Interferences of the United States Patent and Trademark Office entered on April 15, 2009.

The decision was received on April 17, 2009.



Jason Paul DeMont
Attorney for Petitioners



Robert L. Greenberg
Attorney for Petitioners

DeMont & Breyer, LLC
100 Commons Way, Ste 250
Holmdel, NJ 07733
United States of America
(732) 578-0103 x211



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/725,737	11/29/2000	Peter Joseph Giacomini	500-002US	9624
22897 7590 04/17/2009 DEMONT & BREYER, LLC 100 COMMONS WAY, Ste. 250 HOLMDEL, NJ 07733			EXAMINER VU, THONG H	
			ART UNIT 2419	PAPER NUMBER
			NOTIFICATION DATE 04/17/2009	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

docketing@dblawn.com

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte PETER JOSEPH GIACOMINI, WALTER MICHAEL PITIO,
HECTOR FRANCISCO RODRIGUEZ, and
DONALD DAVID SHUGARD

Appeal 2009-0139
Application 09/725,737¹
Technology Center 2600

Decided:² April 15, 2009

Before JOHN A. JEFFERY, MARC S. HOFF, and KARL D. EASTHOM,
Administrative Patent Judges.

HOFF, *Administrative Patent Judge.*

DECISION ON APPEAL

¹ The real party in interest is Broadspider Networks, Inc.

² The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

STATEMENT OF CASE

Appellants appeal under 35 U.S.C. § 134 from a non-final rejection of claims 1, 2, 8, 9, 11, 12, 15, 16, 22-25, 27, 28, 31, and 32.³ We have jurisdiction under 35 U.S.C. § 6(b).

We affirm-in-part.

Appellants' invention relates to a technique for efficiently populating a cache with resources (Spec. 2). Embodiments include populating a cache with a resource only when at least i requests for the resource have been received, wherein i is an integer and is at least occasionally greater than one, wherein i varies with e.g. the time of day, the day of the week, the day of the year, the month of the year, the season of the year, or the year itself (Spec. 10). In another embodiment, the value of i does not change over time or as a function of circumstance (Spec. 9).

Claim 1 is exemplary:

1. A method comprising:
populating a cache with a resource only when at least i requests for said resource have been received;
wherein i is an integer and is at least occasionally greater than one.

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Tran

7,039,683 B1

May 2, 2006
(filed Dec. 29, 2000)

³ Claims 3-7, 10, 13, 14, 17-21, 26, 29, and 30 stand objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form (Ans. 4). Further, we note that Appellants' statement that claims 1-32 stand rejected and are appealed (Br. 6) is erroneous, as is the Examiner's indication that the status of the claims in the Brief is correct (Ans. 2).

Appeal 2009-0139
Application 09/725,737

Teoman	6,463,509 B1	Oct. 8, 2002 (filed Jan. 26, 1999)
Chamberlain	6,408,360 B1	Jun. 18, 2002 (filed Jan. 25, 1999)

Claims 2, 9, 16, and 25 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement.

Claims 1, 8, 11, 12, 15, 22-24, 27, 28, 31, and 32 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Tran.

Claims 1, 8, 11, 12, 15, 22-24, 27, 28, 31, and 32 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Chamberlain.

Claims 1, 8, 11, 12, 15, 22-24, 27, 28, 31, and 32 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Teoman.

Throughout this decision, we make reference to the Appeal Brief (“Br.,” filed May 22, 2007) and the Examiner’s Answer (“Ans.,” mailed Oct. 17, 2007) for their respective details.

ISSUES

Appellants assert that dependent claim 2, which calls for i to be invariant, is not in conflict with independent claim 1, which requires the value of i to be an integer “occasionally greater than one” (Br. 13). With respect to the prior art rejections, Appellants argue that Tran does not qualify as prior art under 35 U.S.C. § 102(e) because its filing date postdates the filing date of the instant application (Br. 15), and that Chamberlain and Teoman fail to anticipate the claimed invention because neither teaches populating a cache with a resource only when at least i requests for the resource have been received, wherein i is an integer and at least occasionally greater than one (Br. 16, 18).

Appellants' arguments present us with the following four issues:

1. Have Appellants shown that the Examiner erred in finding that one of ordinary skill in the art could not make and use the invention of claim 2, in which the value of i is invariant, without undue experimentation?
2. Have Appellants shown that the Examiner erred in finding that Tran qualifies as prior art under 35 U.S.C. § 102(e)?
3. Have Appellants shown that the Examiner erred in finding that Chamberlain teaches populating a cache with a resource only when at least i requests for that resource have been received, wherein i is an integer that is at least occasionally greater than one?
4. Have Appellants shown that the Examiner erred in finding that Teoman teaches populating a cache with a resource only when at least i requests for that resource have been received, wherein i is an integer that is at least occasionally greater than one?

FINDINGS OF FACT

The following Findings of Fact (FF) are shown by a preponderance of the evidence.

The Invention

1. According to Appellants, the invention concerns a technique for efficiently populating a cache with resources (Spec. 2). Embodiments include populating a cache with a resource only when at least i requests for the resource have been received, wherein i varies with e.g. the time of day, the day of the week, the day of the year, the month of the year, the season of the year, or the year itself (Spec. 10). In another embodiment, the value of i does not change (Spec. 9).

2. According to Appellants' Specification, "[i]n some cases, the value of i is one, and in other cases the value of i is an integer greater than one. In some cases, the value of i is invariant (*i.e.*, it does not change over time or as a function of circumstance)" (Spec. 9).

Tran

3. Tran teaches electronic information caching based on an anticipated demand for that information. Anticipating future requests for access to selected information may be based on, for example, past requests for access to the same or related electronic information. Requests for access may be anticipated before, after, or while an access request is made (col. 1, ll. 27-31, 49-52, and 66-67).

4. Tran includes an "anticipating module" that may be designed to determine the rate or number of requests for electronic information, and to electronically flag electronic information as being in high demand by access requesters where the cache value or frequency of requests for the electronic information is high (col. 4, ll. 32-40).

5. Provisional Application No. 60/234,996, from which Tran claims priority under 35 U.S.C. § 119(e), discloses that "[a]nticipating requests for electronic information . . . is generally performed based on one ore [sic] more criteria, e.g., past requests for information" (p. 3, ll. 20-21).

Chamberlain

6. Chamberlain teaches a caching system and method that allow for the caching of web pages that have dynamic content, using a cacheability analyzer that analyzes responses based on time, content, user identification, and macro hierarchy (Abstract).

7. Chamberlain teaches various applicability tests for determining whether a dynamic web page should be cached, including tests for appropriate browser type and version and tests for the appropriate language (col. 14, ll. 19-26).

Teoman

8. Teoman teaches an apparatus and method for caching data in a storage device of a computer system. Data is preloaded and responsively cached in the user-configurable cache memory based on user preferences (Abstract).

9. Teoman teaches that, as part of a user cache manager, “a user may specify that, after a threshold number of files within a directory have been accessed, all the files in the directory are to be preloaded” (col. 10, ll. 40-43).

PRINCIPLES OF LAW

“A rejection for anticipation under section 102 requires that each and every limitation of the claimed invention be disclosed in a single prior art reference.” *See In re Buszard*, 504 F.3d 1364, 1366 (Fed. Cir. 2007) (quoting *In re Paulsen*, 30 F.3d 1475, 1478-79 (Fed. Cir. 1994)).

Anticipation of a claim requires a finding that the claim at issue reads on a prior art reference. *Atlas Powder Co. v. IRECO Inc.*, 190 F.3d 1342, 1346 (Fed. Cir. 1999) (citing *Titanium Metals Corp. v. Banner*, 778 F.2d 775, 781 (Fed. Cir. 1985)).

“The test of enablement is whether one reasonably skilled in the art could make or use the invention from the disclosures in the patent coupled

with information known in the art without undue experimentation.” *United States v. Telectronics, Inc.*, 857 F.2d 778, 785 (Fed. Cir. 1988).

“[A] patent disclosure need not enable information within the knowledge of an ordinarily skilled artisan. Thus, a patentee preferably omits from the disclosure any routine technology that is well known at the time of application.” *Chiron Corp. v. Genentech, Inc.*, 363 F.3d 1247, 1254 (Fed. Cir. 2004).

ANALYSIS

§ 112 REJECTION

Each of claims 2, 9, 16, and 25, rejected as lacking enablement, recites that “the value of i is invariant.” The Examiner stated that “claim 1 clearly recited i is variable by reciting the i is occasional [sic] greater than 1. It can’t be invariant” (Ans. 3).

We do not find the Examiner’s reasoning persuasive. Claim 1 (and all other pending independent claims) recites that “ i is an integer and is at least occasionally greater than one.” The Specification discloses that “[i]n some cases, the value of i is one, and in other cases the value of i is an integer greater than one. In some cases, the value of i is invariant (*i.e.*, it does not change over time or as a function of circumstance)” (FF 2). If i is at least occasionally greater than one (as claim 1 requires), it is therefore possible that i could be invariant (as claim 2 requires), and always be equal to two, or three, or any other integer greater than one, without doing violence to the requirement of claim 1. We find, therefore, that Appellant’s Specification discloses the invention of claim 2 such that one of ordinary skill in the art could make and use it without undue experimentation.

Because Appellants have shown error in the Examiner's rejection of claims 2, 9, 16, and 25 under 35 U.S.C. § 112, first paragraph, we will not sustain the rejection.

§ 102 REJECTION OVER TRAN

We select claim 1 as representative of this group, pursuant to our authority under 37 C.F.R. § 41.37(c)(1)(vii).

Appellants argue that Tran does not qualify as prior art because “[t]he 102(e) filing date of Tran is 29 December 2000, which is after the filing date of the present application (29 November 2000)” (Br. 15).

The Examiner correctly points out, however, that Tran claims domestic priority under 35 U.S.C. § 119(e) from a provisional application⁴ filed 25 September 2000, which is prior to the filing date of the present application (Ans. 10). Tran therefore does qualify as prior art, based on the filing date of the provisional application. Appellants make no argument in the Brief that the provisional application does not support the subject matter relied upon to make the § 102(e) rejection in compliance with § 112, first paragraph. *See Ex parte Yamaguchi*, 88 USPQ2d 1606 (BPAI 2008) (precedential). Appellants have therefore failed to carry their burden of establishing that the Examiner erred in applying Tran against the claimed invention.

Tran teaches electronic information caching including an “anticipating module” that may be designed to determine the rate or number of requests [plural] for electronic information, and to electronically flag electronic information as being in high demand by access requesters where the cache

⁴ Provisional Application No. 60/234,996 (hereinafter “The Provisional Application”).

value or frequency of requests for the electronic information is high (FF 4). Tran thus teaches populating its cache with the “electronic information” when at least i requests for that information have been received, wherein i is an integer at least occasionally greater than one (i.e., Tran caches electronic information that has been subject to *plural* “requests”). The Provisional Application supports this subject matter, noting that “[a]nticipating requests for electronic information . . . is generally performed based on one ore [sic] more criteria, e.g., past *requests* for information” (FF 5 (emphasis added)).

Therefore, because Appellants have not established error in the Examiner’s rejection, we will sustain the Examiner’s rejection of claims 1, 8, 11, 12, 15, 22-24, 27, 28, 31, and 32 under 35 U.S.C. § 102.

§ 102 REJECTION OVER CHAMBERLAIN

The Examiner finds that Chamberlain teaches populating a cache with a resource only when at least i requests for the resource have been received, wherein i is an integer and at least occasionally greater than one (Ans. 5), as is recited in each of independent claims 1, 8, 15, and 24. The section of Chamberlain (FF 7) cited by the Examiner, however, generally describes tests that may be run against a cached response to ensure that it is applicable to the request or the requesting user (*id.*), but does not teach populating a cache with a resource after i requests for the resource, i being an integer at least occasionally greater than one. While it is possible that one of such tests *could* be whether a web page has been requested at least i times, i being an integer at least occasionally greater than one, it would be speculation to assert that exactly such a test is performed in Chamberlain’s invention. Likewise, we do not find any other disclosure in Chamberlain to the effect

that Chamberlain populates a cache with a resource in response to at least i requests for said resource, wherein i is at least occasionally greater than one. As a result, we find that Chamberlain does not teach all of the elements of claim 1.

Appellants have thus established error in the Examiner's rejection, and we will not sustain the § 102 rejection of claims 1, 8, 11, 12, 15, 22-24, 27, 28, 31, and 32 as being anticipated by Chamberlain.

§ 102 REJECTION OVER TEOMAN

We select claim 1 as representative of this group, pursuant to our authority under 37 C.F.R. § 41.37(c)(1)(vii).

Appellants argue that the Examiner erred in rejecting claim 1 as being anticipated by Teoman because Teoman does not teach delaying the population of a cache with a resource until at least i requests for the resource have been received, wherein i is at least occasionally greater than one (Br. 18).

Teoman teaches, however, that as part of a user cache manager, "a user may specify that, after a threshold number of files within a directory have been accessed, all the files in the directory are to be preloaded" (FF 9). Teoman thus teaches populating a cache with a resource (i.e., a directory) when at least i requests for that resource (i.e., files making up that directory) have been received, wherein i is an integer at least occasionally greater than one (because Teoman teaches loading a directory in response to (plural) "requests," Teoman teaches at minimum a situation where i is always equal to 2 [or more], which is at least occasionally greater than one).

We therefore find that Appellants have failed to establish error in the Examiner's § 102 rejection of claims 1, 8, 11, 12, 15, 22-24, 27, 28, 31, and 32 as being anticipated by Chamberlain, and we will sustain the rejection.

CONCLUSIONS OF LAW

1. Appellants have shown that the Examiner erred in finding that one of ordinary skill in the art could not make and use the invention of claim 2, in which the value of i is invariant, without undue experimentation.

2. Appellants have not shown that the Examiner erred in finding that Tran qualifies as prior art under 35 U.S.C. § 102(e).

3. Appellants have shown that the Examiner erred in finding that Chamberlain teaches populating a cache with a resource only when at least i requests for that resource have been received, wherein i is an integer that is at least occasionally greater than one.

4. Appellants have not shown that the Examiner erred in finding that Teoman teaches populating a cache with a resource only when at least i requests for that resource have been received, wherein i is an integer that is at least occasionally greater than one.

ORDER

The Examiner's rejection of claims 2, 9, 16, and 25 under 35 U.S.C. § 112 is reversed. The Examiner's rejection of claims 1, 8, 11, 12, 15, 22-24, 27, 28, 31, and 32 under 35 U.S.C. § 102 as anticipated by Tran is affirmed. The Examiner's rejection of claims 1, 8, 11, 12, 15, 22-24, 27, 28, 31, and 32 under 35 U.S.C. § 102 as anticipated by Chamberlain is reversed. The

Appeal 2009-0139
Application 09/725,737

Examiner's rejection of claims 1, 8, 11, 12, 15, 22-24, 27, 28, 31, and 32 under 35 U.S.C. § 102 as anticipated by Teoman is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED-IN-PART

babc

DEMONT & BREYER, LLC
100 COMMONS WAY, Ste. 250
HOLMDEL NJ 07733